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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,597	03/26/2001	Motoki Nakade	450100-03084	7826

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EXAMINER	
JOHNS, CHRISTOPHER C	
ART UNIT	PAPER NUMBER
3621	
MAIL DATE	DELIVERY MODE
07/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/817,597	NAKADE ET AL.	
	Examiner	Art Unit	
	Christopher C. Johns	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7,8 and 10-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 7, 8, and 10-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20090626 for reference purposes only.

2. This Office Action is in response to the Response to Non-Final Office Action, filed 17 April 2009.

3. All references to the capitalized version of "Applicant" refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.

4. Claims 1-4, 7, 8, and 10-22 are pending.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 7, 8, 12-19, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 7,072,856 ("Nachom") in view of United States Patent RE39,898 ("Nally").

7. As per claims 1-4, 7, 8, 12-19, and 22, Nachom teaches:

8. connecting a plurality of communication terminals to each other and transmitting signals between said terminals (figures 1 and 2);

9. superposing a second advertisement image over a first image and transmitting the superposed image to a user (figure 2; column 5, lines 10-33);

10. prescribed area in the first image data is determined based on…a usage of the one or more products (the popup in Nachom is sized according to the data enclosed in the popup, see figure 5, reference number 26. Further, it is inherent in the computing arts to create appropriately-sized windows).

11. transmitting advertisements to users of said terminals (figure 2; column 5, lines 10-33) and providing information to said users in response to a demand from said users (column 5, lines 33-43);

12. superposed image data (figure 2, reference number 26 - the data contained in that window is an image in and of itself).

13. displaying a transaction environment to the users (column 5, line 43 – column 6, line 6);

14. replacing an area of the first image data with the second image data and blending the data at a prescribed ratio (see column 5, lines 30-35 – "Information may be presented in the form of a pop-up screen or an embedded hyperlink". Using a pop-up screen is a method that replaces a prescribed area of the first image data (the original webpage, figure 2, reference number 20) with second image data);

15. sending the superposed image based on the first user (advertiser) and a second user (consumer) (column 5, line 10 – column 6, line 44);

16. transmitting data over the Internet (column 4, lines 50-61), therefore transmitting data and signals that the Internet typically supports – such as the JPEG, GIF, MPEG, MP3 file formats (well-known to those skilled in the art at the time of the invention)

17. a user completing a transaction at a second site, accessed by clicking on said pop-up ads (see abstract; figure 2, reference numbers 34-40-44, 50, 52 et seq);

18. As per claims 3, 4, 7, 8, and 18, data stored in memory that does not affect a claimed method or apparatus does not distinguish the claims from the prior art (see MPEP 2106.01). Similarly how stored data in memory is arranged for display does not distinguish the claims from prior art (claims 7, 8).

19. As per claim 13, websites that sell multiple products were old and well-known to those skilled in the art at the time of the invention (such as Amazon.com, Buy.com, etc). As Nachom applies his system to companies that perform business over the Internet (column 5, lines 25-50), it would have been obvious to one of ordinary skill in the art at the time of the invention to use Nachom to sell multiple products.

20. Nachom does not explicitly disclose:

21. extracting feature points from the first image according to luminance and color of the first image data;

22. prescribed area in the first image data is determined based on feature points of the first image data.

23. Nally teaches:

24. extracting feature points from the first image according to luminance and color of the first image data (column 10, line 56 - column 11, line 9 - "fig 4a…color comparison circuitry performs the comparisons set forth in Table 1…comparing the 8-bits of graphics pixels receives in the look-up table mode from attribute controller 233");

25. prescribed area in the first image data is determined based on feature points of the first image data (column 2, lines 25-50 - "static graphics data 'in front of' the video data not be destroyed each time the video window is updated…").

26. Nally performs this extraction and prescribing in order to present data on top of other data, as mentioned in column 1, line 56 - column 2, line 15 - "simultaneously displaying video and graphics data on a single display screen involves the generation of 'windows'…stream of data from a selected source is used to generate a display within a particular region or 'window' of the display to the exclusion of any non-selected data streams…".

27. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Nachom the extracting and prescribing as taught by Nally, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it allows multiple sets of data to be presented simultaneously.

28. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nachom, in view of Nally, further in view of US Patent 5,721,827 ("Logan").

29. As per claims 10, 11, 20, and 21, neither Nachom, Nally, nor the combination of both references, explicitly teach compensating a user for viewing advertisements. Logan teaches compensating a user for viewing an ad (see abstract). Logan also teaches targeting advertisements to users based on user preferences (column 9, line 12 – column 10, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined invention of Nachom and Nally to compensate the users for advertisements as is done in Logan, because it would provide a more successful system where more users will click advertisements (because of the obvious financial benefits).

Response to Arguments

30. Applicants' arguments concerning the previous Non-Final Rejection (dated 17 April 2009) are persuasive; consequently, new grounds of rejection have been entered.

31. Applicants argue, "this response does not comment on each and every comment made by the Examiner in the Office action. This should not be taken as acquiescence of the substance of those comments, and Applicants reserve the right to address such comments" (remarks, page 14). Applicants' reservation is hereby denied. The Examiner disagrees since there *is* a need to address the remaining errors since 37 C.F.R. §1.111(b) *requires* Applicants to address the remaining errors.

32. Applicants are reminded that examiners have no authority to waive 37 C.F.R. §1.111(b). See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987). Additionally an applicant is required to point out *any* supposed errors in the office action in his or her next response. In this application, the Examiner is therefore presented with two possible scenarios.

33. First, the Examiner could treat the remarks filed 17 April 2009 as a violation of 37 C.F.R. §1.111(b) since Applicants have shown express intent (as noted above) to not respond to the 'comments' made in the 23 January 2009 Office Action.

34. Second, the Examiner could alternatively treat the remarks filed 17 April 2009 as complying with 37 C.F.R. §1.111(b). In order to comply with the second scenario, the remarks must therefore be considered a waiver of any right to respond to any rejections that are not responded to.

35. In light of the above and to provide compact prosecution while reducing pendency, the Examiner chooses scenario two. Thus, it is the Examiner's position that any arguments Applicants should have made in their remarks are hereby waived. Applicants are cautioned that should Applicants present any arguments that could have been made in their remarks and/or are directed to the arguments made by the Examiner, the Examiner will have no choice but to treat the past remarks as being in violation of 37 C.F.R. §1.111(b) (*i.e.* Scenario one). If the remarks are in violation of 37 C.F.R. §1.111(b), this application is abandoned (see *In re Goodman*, 3 USPQ2d 1866 (ComrPats 1987)).

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. United States Patent 6,377,269 (Kay);

38. United States Patent RE39,214 (Gryskiewicz).

39. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

40. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621